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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/781,949
Filing Date: February 20, 2004
Appellant(s): GING ET AL.

John P. Darling
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on September 30th, 2008 appealing from the Office action mailed March 4th, 2008.

(1) Real Party in Interest

A statement identifying the real party interest is contained in the brief.

(2) Related Appeals and Interferences

The brief contains a statement identifying that the appellant, the undersigned, and the assignee are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by o have a bearing on the Board's decision in this appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments

An amendment after final rejection was filed on June 4th, 2008. Claims 7, 19 and 25-27 were cancelled and claims 8, 9, 20 and 22 were rewritten in independent form. An advisory action filed on August 14th, 2008 indicated that the amendment filed on June 4th, 2008 will be entered for purposes of appeal.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Apppeal

The ground of rejection set forth in the appeal brief is correct.

(7) Claims Appendix

The appealed claims in the appendix of the brief are correct.

(8) Evidence Relied Upon

7,007,696 Palkon et al. 03-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable the appealed claims:

Amended claims 8-12 and 20-24 are rejected under 35 U.S.C. § 103(a) over Palkon et al. (US 7,007,696).

Claims **8-12 and 20-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Palkon et al. (US 7,007,696).

As to claim 8, Palkon substantially discloses an apparatus that comprises an outer membrane **31** including a face-contact portion to form a seal with the patient; a frame connection portion opposite the face contact portion **(see figures 1 and 2)**; an inwardly sloping or stepped outer wall between the outer membrane and the frame connection portion **(see figures 1-5)**; and an underlying rim **48** positioned below the membrane **(see figures 6 and 7)**, wherein the membrane and the rim are formed and positioned with respect to one another to accommodate at least one of a pre-adult patient or a small sized adult patient and the cushion includes a nasal bridge region **38**; a top lip region **39** and two side regions **40 (see figure 3)**, and wherein a

projected area of the frame connection portion is generally larger than an area defined by the face-contact portion of the membrane **(see figure 1)**, wherein the membrane and rim each have an orifice **(see figure 3)** but does not disclose a width of the membrane orifice being between 30 and 32mm in the lip region, between about 18 and 20mm in each side region, and between about 22 and 24mm in the nasal bridge region, a width of the rim orifice being about 34 and 36mm in the nasal bridge region, between about 32 and 34mm in the lip region, and between about 42 and 44mm in each of he side regions of the cushion, the membrane height that is about 27 and 35mm in the nasal region, between about 19 and 22mm in the lip region, and between about 33-35mm in each side regions, the rim height being between about 13 and 18mm in the nasal bridge region and the lip region and the rim height in each of the side portions being between 25-27mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palkon's invention by providing a width of the membrane orifice being between 30 and 32mm in the lip region, between about 18 and 20mm in each side region, and between about 22 and 24mm in the nasal bridge region, a width of the rim orifice being about 34 and 36mm in the nasal bridge region, between about 32 and 34mm in the lip region, and between about 42 and 44mm in each of he side regions of the cushion, the membrane height that is about 27 and 35mm in the nasal region, between about 19 and 22mm in the lip region, and between about 33-35mm in each side regions, the rim height being between about 13 and 18mm in the nasal bridge region and the lip region and the rim height in each of the side portions being between 25-27mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller*, 105 USPQ 233.**

As to claims 9 and 22, Palkon substantially discloses an apparatus that comprises an outer membrane **31** including a face-contact portion to form a seal with the patient; a frame connection portion opposite the face contact portion **(see figures 1 and 2)**; an inwardly sloping or stepped outer wall between the outer membrane and the frame connection portion **(see figures 1-5)**; and an underlying rim **48** positioned below the membrane **(see figures 6 and 7)**, wherein the membrane and the rim are formed and positioned with respect to one another to accommodate at least one of a pre-adult patient or a small sized adult patient and the cushion includes a nasal bridge region **38**; a top lip region **39** and two side regions **40 (see figure 3)**, and wherein a projected area of the frame connection portion is generally larger than an area defined by the face-contact portion of the membrane **(see figure 1)** but does not disclose an aperture having a width between about 30-42mm, an effective height as vertically measured from an edge of the rim to a top of the cushion as seen in plan view of between about 32-42mm, and an effective bridge depth of between about 13-24mm as vertically measured from the membrane in the nasal bridge region to the rim in each side region in top view. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palkon's invention by providing an aperture having a width between about 30-42mm, an effective height as vertically measured from an edge of the rim to a top of the cushion as seen in plan view of between about 32-42mm, and an effective bridge depth of between about 13-24mm as vertically measured from the membrane in the nasal bridge region to the rim in each side region in top view, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller*, 105 USPQ 233.**

As to claims 10 and 23, Palkon substantially discloses the claimed invention, see rejection of claim 7 above, bust does not disclose a width that is between about 39-40mm, the height is about 35mm and the depth is less than about 15mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palkon's invention by providing a width that is between about 39-40mm, the height is about 35mm and the depth is less than about 15mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller*, 105 USPQ 233.**

As to claims 11 and 24, Palkon substantially discloses the claimed invention, see rejection of claim 7 above, bust does not disclose a width that is between about 34-35mm, the height is about 40mm and the depth is about 20mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palkon's invention by providing a width that is between about 34-35mm, the height is about 40mm and the depth is about 20mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller*, 105 USPQ 233.**

As to claim 12, Palkon substantially discloses an apparatus that comprises a membrane that generally follows a contour of the rim **(see figures 6 and 7)**.

As to claim 20, Palkon substantially discloses an apparatus that comprises an outer membrane **31** including a face-contact portion to form a seal with the patient; a frame connection portion opposite the face contact portion **(see figures 1 and 2)**; an inwardly sloping or stepped outer wall between the outer membrane and the frame connection portion **(see figures 1-5)**; and

an underlying rim **48** positioned below the membrane **(see figures 6 and 7)**, wherein the membrane and the rim are formed and positioned with respect to one another to accommodate at least one of a pre-adult patient or a small sized adult patient and the cushion includes a nasal bridge region **38**; a top lip region **39** and two side regions **40 (see figure 3)**, and wherein a projected area of the frame connection portion is generally larger than an area defined by the face-contact portion of the membrane **(see figure 1)** wherein the membrane and the rim are formed and positioned with respect to one another to accommodate a pre-adult aged 16 years or less but bust does not disclose a width of the membrane orifice being between 30 and 32mm in the lip region, between about 18 and 20mm in each side region, and between about 22 and 24mm in the nasal bridge region, a width of the rim orifice being about 34 and 36mm in the nasal bridge region, between about 32 and 34mm in the lip region, and between about 42 and 44mm in each of he side regions of the cushion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palkon's invention by providing a width of the membrane orifice being between 30 and 32mm in the lip region, between about 18 and 20mm in each side region, and between about 22 and 24mm in the nasal bridge region, a width of the rim orifice being about 34 and 36mm in the nasal bridge region, between about 32 and 34mm in the lip region, and between about 42 and 44mm in each of he side regions of the cushion, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller*, 105 USPQ 233.**

As to claim 21, Palkon substantially discloses the claimed invention, see rejection of claim 7 above, bust does not disclose a membrane height that is about 27 and 35mm in the nasal

region, between about 19 and 22mm in the lip region, and between about 33-35mm in each side regions, the rim height being between about 13 and 18mm in the nasal bridge region and the lip region and the rim height in each of the side portions being between 25-27mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Palkon's invention by providing a membrane height that is about 27 and 35mm in the nasal region, between about 19 and 22mm in the lip region, and between about 33-35mm in each side regions, the rim height being between about 13 and 18mm in the nasal bridge region and the lip region and the rim height in each of the side portions being between 25-27mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller*, 105 USPQ 233.**

(10) Response to Arguments

In reference to claim 8, Appellant argues that Palkon does not disclose or suggest any values for the width of the membrane orifice, the width of the rim orifice, the membrane heights in each of the three regions, including the lip region, the nasal bridge region, and the side regions and/or the rim heights in each of the three regions. The examiner disagrees with Appellant's arguments. The dimension values of the membrane orifice, rim orifice, membrane heights in each of the three regions, lip region, nasal bridge region, side regions in each of the three regions as described in claim 8 will depend on the size of the particular patient; the patient may be babies, kids or adults. Not all babies, kids or adults have the same size reqirements and they will differ between one another. Since the size of the device depends on the size of the patient (i.e. babies, kids or an adults) this is considered to be an obvious matter of design choice.

Appellant further argues that Palkon does not disclose or suggest any underlying rim positioned below the membrane. The examiner disagrees with appellant's argument. Palkon does disclose an underlying rim 48 that is positioned below the membrane 31 (see col. 3 lines 40-50).

In reference to claims 9 and 22, appellant argues that Palkon does not disclose or suggest any values for the width of the aperture in the rim region, the height from the edge of the rim to a top of the cushion and the depth of the bridge. The examiner disagrees with appellant's argument. The dimension values for the width of the aperture in the rim region, the height from the edge of the rim to a top of the cushion and the depth of the bridge as described in claims 9 and 22 will depend of the size particular patient; the patient may be babies, kids or adults. Not all babes, kids or adults have the same size. Since the size of the device depends on the size of the baby, kids or an adult is considered to be an obvious matter of design choice.

In reference to claim 20 and 21, appellant argues that Palkon does not disclose a width of the membrane orifice is between about 30 and 32mm in the lip region, between about 18-20mm in each side region, and between about 22 and 24mm in the nasal bridge region, a width of the rim orifice is about 34 and 36mm in the nasal bridge region, between about 32 and 34mm in the lip region, and between about 42 and 44mm in each side region of the cushion. The examiner disagrees with the appellant's argument. The width of the membrane orifice is between about 30 and 32mm in the lip region, between about 18-20mm in each side region, and between about 22 and 24mm in the nasal bridge region, a width of the rim orifice is about 34 and 36mm in the nasal bridge region, between about 32 and 34mm in the lip region, and between about 42 and 44mm in each side region of the cushion depend on the size of babies, kids and adults. Not all babes, kids or adults have the same size. Since the size of the device depends on the size of the

baby, kids or an adult is considered to be an obvious matter of design choice.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/Nihir Patel/
Examiner, Art Unit 3772

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TC 3700 RQAS